

AO 120 (Rev. 2/99)

<b>TO: Mail Stop 8</b> <b>Director of the U.S. Patent &amp; Trademark Office</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	<b>REPORT ON THE</b> <b>FILING OR DETERMINATION OF AN</b> <b>ACTION REGARDING A PATENT OR</b> <b>TRADEMARK</b>
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
filed in the U.S. District Court Northern District California on the ☒ Patents or ☐ Trademarks:

DOCKET NO. <b>CV 11-05243 RS</b>	DATE FILED <b>May 3, 2012</b>	U.S. DISTRICT COURT <b>450 Golden Gate Avenue, 16<sup>th</sup> Floor, San Francisco CA 94102</b>
PLAINTIFF <b>SANDISK CORPORATION</b>		DEFENDANT <b>ROUND ROCK RESEARCH LLC.</b>
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
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4		
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In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input checked="" type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		<b>***See Attach Amended Complaint***</b>
2		
3		
4		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK  Richard W. Wieking	(BY) DEPUTY CLERK  Gina Agustine-Rivas	DATE  May 7, 2012
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Copy 1—Upon initiation of action, mail this copy to Commissioner    Copy 3—Upon termination of action, mail this copy to Commissioner  
Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner    Copy 4—Case file copy

**FIFTH CAUSE OF ACTION**  
**(Declaratory Judgment of Non-Infringement of the '586 Patent)**

60. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

61. The '586 patent issued on August 7, 2001 to named inventors Frankie Roohparvar, Darrell Rinerson, Christophe Chevallier and Michael Briner and is entitled "Memory system having programmable control parameters."

62. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '586 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

63. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '586 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '586 patent by selling "SanDisk microSD Memory Cards and iNAND eMMC EFDs."

64. SanDisk contends that it is not required to license the '586 patent from Round Rock because, among other reasons, the claims of the '586 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '586 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '586 patent are exhausted.

65. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '586 patent by SanDisk.

66. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '586 patent are infringed by SanDisk's flash memory products. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '586 patent.

**SIXTH CAUSE OF ACTION**  
**(Declaratory Judgment of Non-Infringement of the '791 Patent)**

67. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

68. The '791 patent issued on May 27, 2005 to named inventors Frankie Roohparvar and Kevin Widmer and is entitled "Flash memory with DDRAM interface."

69. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '791 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

70. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '791 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '791 patent by selling "SanDisk iNAND eMMC EFDs".

71. SanDisk contends that it is not required to license the '791 patent from Round Rock because, among other reasons, the claims of the '791 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '791 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '791 patent are exhausted.

72. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '791 patent by SanDisk.

73. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '791 patent are infringed by SanDisk's flash memory products. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '791 patent.

**SEVENTH CAUSE OF ACTION  
(Declaratory Judgment of Non-Infringement of the '334 Patent)**

74. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

75. The '334 patent issued on January 27, 2009 to named inventor Chang Ha and is entitled "Interleaved input signal path for multiplexed input."

76. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '334 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

77. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '334 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '334 patent by selling "solid state drives, products compliant with the ONFi standard, and/or products utilizing error correction code Zero NAND ('EZ-NAND') protocol".

78. SanDisk contends that it is not required to license the '334 patent from Round Rock because, among other reasons, the claims of the '334 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '334 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '334 patent are exhausted.

79. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '334 patent by SanDisk.

80. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '334 patent are infringed by SanDisk's flash memory products. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '334 patent.

**EIGHTH CAUSE OF ACTION**  
**(Declaratory Judgment of Non-Infringement of the '209 Patent)**

81. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

82. The '209 patent issued on July 3, 2001 to named inventors Trung Doan, Gurtej Sandhu, Kirk Prall and Sujit Sharan and is entitled "Methods of forming a contact having titanium formed by chemical vapor deposition."

83. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '209 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

84. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '209 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '209 patent by selling "SanDisk iNAND eMMC EFDs, SSDs, and the SanDisk family of SD Memory Cards".

85. SanDisk contends that it is not required to license the '209 patent from Round Rock because, among other reasons, the claims of the '209 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '209 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '209 patent are exhausted.

86. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '209 patent by SanDisk.

87. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '209 patent are infringed by SanDisk's flash memory products. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '209 patent.

**NINTH CAUSE OF ACTION  
(Declaratory Judgment of Non-Infringement of the '282 Patent)**

88. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

89. The '282 patent issued on July 21, 1998 to named inventor Shane Leiphart and is entitled "Resputtering to achieve better step coverage of contact holes."

90. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '282 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

91. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '282 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '282 patent by selling "SanDisk iNAND eMMC EFDs, SSDs, and the SanDisk family of SD Memory Cards".

92. SanDisk contends that it is not required to license the '282 patent from Round Rock because, among other reasons, the claims of the '282 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '282 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '282 patent are exhausted.

93. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '282 patent by SanDisk.

94. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '282 patent are infringed by SanDisk's flash memory products. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '282 patent.

**TENTH CAUSE OF ACTION**  
**(Declaratory Judgment of Non-Infringement of the '344 Patent)**

95. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

96. The '344 patent issued on February 15, 1994 to named inventors Guy Blalock, David Becker and Fred Roe and is entitled "Process for selectively etching a layer of silicon dioxide on an underlying stop layer of silicon nitride."

97. Micron previously sued SanDisk for infringement of the '344 patent. That lawsuit was settled and dismissed between the companies on mutually agreeable terms in 2002. As Micron's lawful assignee of the '344 patent, Round Rock is bound by the settlement agreement between Micron and SanDisk with regard to the '344 patent.

98. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '344 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

99. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '344 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '344 patent by selling "SanDisk iNAND eMMC EFDs, SSDs, and the SanDisk family of SD Memory Cards".

100. SanDisk contends that it is not required to license the '344 patent from Round Rock because, among other reasons, the claims of the '344 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '344 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '344 patent are exhausted.

101. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '344 patent by SanDisk.





1 and initially sold by a licensee under the '760 patent. Because the accused flash memory products  
2 were sold by an authorized licensee, Round Rock's rights under the '760 patent are exhausted.

3 109. As a result of the acts described in this Second Amended Complaint, there exists a  
4 substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory  
5 judgment as to infringement of the '760 patent by SanDisk.

6 110. An actual and justiciable controversy exists between SanDisk and Round Rock as to  
7 whether the claims of the '760 patent are infringed by SanDisk's flash memory products. A judicial  
8 declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '760  
9 patent.

10 **TWELFTH CAUSE OF ACTION**  
11 **(Declaratory Judgment of Non-Infringement of the '053 Patent)**

12 111. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31  
13 of this Second Amended Complaint as though set forth in full herein.

14 112. The '053 patent issued on January 18, 2005 to named inventor Christophe Chevallier  
15 and is entitled "Power Throughput Adjustment in Flash Memory."

16 113. Round Rock has asserted that SanDisk's eMMC iNAND Flash Model No. SDIN4C2-  
17 16G infringes claims of the '053 patent.

18 114. SanDisk contends that it is not required to license the '053 patent from Round Rock  
19 because, among other reasons, the claims of the '053 patent are exhausted with respect to SanDisk's  
20 flash memory products. On information and belief, the accused flash memory products were made  
21 and initially sold by a licensee under the '053 patent. Because the accused flash memory products  
22 were sold by an authorized licensee, Round Rock's rights under the '053 patent are exhausted.

23 115. As a result of the acts described in this Second Amended Complaint, there exists a  
24 substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory  
25 judgment as to infringement of the '053 patent by SanDisk.

26 116. An actual and justiciable controversy exists between SanDisk and Round Rock as to  
27 whether the claims of the '053 patent are infringed by SanDisk's flash memory products. A judicial  
28

1 declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '053  
2 patent.

3 **PRAYER FOR RELIEF**

4 WHEREFORE, SanDisk prays that this Court:

5 A. Issue a declaration that SanDisk's flash memory products have not infringed and do  
6 not infringe, either directly or indirectly, any valid claim of the '345 patent, the '586 patent, the '791  
7 patent, the '334 patent, the '209 patent, the '282 patent, the '344 patent, the '760 patent, or the '053  
8 patent;

9 B. Issue a declaration that the '520 patent, the '528 patent, and the '839 patent are  
10 invalid;

11 C. Issue an order enjoining Round Rock, its officers, agents, servants, employees,  
12 attorneys, parent and subsidiary corporations, assigns and successors in interest, and those persons in  
13 active concert or participation with them, from alleging that SanDisk and/or SanDisk's customers  
14 infringe any of the Round Rock Asserted Patents by making, using, selling, offering to sell or  
15 importing SanDisk flash memory products;

16 D. Issue an order declaring that SanDisk is the prevailing party and that this is an  
17 exceptional case under 35 U.S.C. § 285 and award SanDisk its reasonable attorneys fees, expenses,  
18 and costs in this action; and

19 E. Issue such other and further relief as this Court deems just and proper.

20 **DEMAND FOR JURY TRIAL**

21 Pursuant to Federal Rule of Civil Procedure 38(b) and Northern District of California Local  
22 Rule 3-6(a), SanDisk respectfully requests a trial by jury of all matters to which it is entitled to a trial  
23 by jury.

24 Dated: May 2, 2012

Respectfully Submitted,

VINSON & ELKINS LLP

26 By: /s/ Chuck P. Ebertin  
Chuck P. Ebertin

27 Attorneys for Plaintiff  
28 SANDISK CORPORATION

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8 UNITED STATES DISTRICT COURT  
9 NORTHERN DISTRICT OF CALIFORNIA  
10

11 SANDISK CORPORATION,  
12 Plaintiff,  
13 vs.  
14 ROUND ROCK RESEARCH LLC,  
15 Defendants.  
16

Case No. 3:11-cv-05243-RS

**SECOND AMENDED COMPLAINT FOR  
DECLARATORY JUDGMENT OF  
PATENT NON-INFRINGEMENT AND/OR  
PATENT INVALIDITY**

**DEMAND FOR JURY TRIAL**

17 Pursuant to Federal Rule of Civil Procedure 15(a)(2) and Round Rock's written consent that  
18 amended pleadings could be filed without leave of Court before September 1, 2012 (*see* Dkt. No. 64  
19 at ¶ 5), Plaintiff SanDisk Corporation ("SanDisk") hereby alleges as follows:

20 **NATURE OF THE ACTION**

21 1. This is an action for a declaratory judgment of non-infringement and/or invalidity of  
22 United States Patent Nos. 5,682,345 ("the '345 patent"), 6,272,586 ("the '586 patent"), 6,570,791  
23 ("the '791 patent"), 7,483,334 ("the '334 patent"), 6,383,839 ("the '839 patent"), 6,900,528 ("the  
24 '528 patent"), 7,021,520 ("the '520 patent"), 6,255,209 ("the '209 patent"), 5,783,282 ("the '282  
25 patent"), 5,286,344 ("the '344 patent"), 6,015,760 ("the '760 patent"), and 6,845,053 ("the '053  
26 patent"). The '345 patent, the '586 patent, the '791 patent, the '334 patent, the '839 patent, the '528  
27 patent, the '520 patent, the '209 patent, the '282 patent, the '344 patent, the '760 patent, and the '053  
28 patent, are collectively referred to herein as the "Round Rock Asserted Patents."

1 **THE PARTIES**

2 2. Plaintiff SanDisk is a corporation organized and existing under the laws of Delaware,  
3 and has its headquarters and principal place of business in Milpitas, California. SanDisk is engaged  
4 in the business of, among other things, designing and selling flash memory products. SanDisk is a  
5 global leader in flash memory storage solutions, from research and development, product design and  
6 manufacturing to branding and distribution for OEM and retail channels. Since 1988, SanDisk's  
7 innovations in flash memory and storage system technologies have provided customers with new  
8 and transformational digital experiences.

9 3. Defendant Round Rock Research, LLC ("Round Rock") is a Delaware limited  
10 liability company with its principal place of business at Mount Kisco, New York.

11 **JURISDICTION**

12 4. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 *et seq.*, and  
13 under the patent laws of the United States, Title 35 of the United States Code. This Court has  
14 jurisdiction over this action pursuant to 35 U.S.C. §§ 271, *et seq.*, and 28 U.S.C. §§ 1331, 1338, and  
15 2201-2202.

16 5. Venue is proper in this District under 28 U.S.C. § 1391 and 1400(b) because a  
17 substantial part of the events giving rise to the claims at issue occurred in this District.

18 6. This Court has personal jurisdiction over Round Rock by virtue of the business  
19 activities it conducts within the State of California and within this District, resulting in sufficient  
20 minimum contacts with this forum.

21 **INTRADISTRICT ASSIGNMENT**

22 7. This case is an Intellectual Property Action under Civil Local Rule 3-2(c) and,  
23 pursuant to Civil Local Rule 3-5(b), has been assigned on a district-wide basis to the Honorable  
24 Judge Richard Seeborg.

25 **GENERAL ALLEGATIONS**

26 8. Round Rock does not compete with SanDisk in the marketplace for flash memory  
27 products.

1           9.       Round Rock is not in the business of manufacturing or selling flash memory products  
2 and does not make, sell or design any commercial products.

3           10.      Round Rock is in the business of patent licensing and monetization.

4           11.      Round Rock approached SanDisk seeking to license patents to SanDisk that Round  
5 Rock acquired from Micron Technology, Inc. ("Micron").

6           12.      Round Rock has a contractual arrangement with IPValue Management, Inc.  
7 ("IPValue") to assist Round Rock with commercialization efforts with regard to the Round Rock  
8 patents. Upon information and belief, IPValue files state income taxes in California. Upon  
9 information and belief, the majority of IPValue's employees are located in its California office.  
10 Upon information and belief, Zahid Rahimtoola is the chief financial officer of IPValue. Upon  
11 information and belief, Gemas Capital Inc. ("Gemas Capital") was established in June 2009 by  
12 Zahid Rahimtoola. Upon information and belief, Gemas Capital is located at 650 Castro Street,  
13 Suite 120-376, in Mountain View, California. Upon information and belief, Gemas Capital retains a  
14 security interest in Round Rock and in the Round Rock Asserted Patents through various contractual  
15 arrangements.

16           13.      Mr. Gerald A. deBlasi is a Vice President at Round Rock. As a Vice President of  
17 Round Rock, Mr. deBlasi affirmatively represented to SanDisk by letter dated August 3, 2011, that  
18 Round Rock "has appointed IPVALUE Management, Inc. as its agent to commercialize Round  
19 Rock's patents and other intellectual property rights worldwide."

20           14.      Mr. deBlasi, in addition to being a Vice President of Round Rock, is also a member  
21 of the Board of Directors of IPValue.

22           15.      IPValue maintains an office in Mountain View, California.

23           16.      IPValue employs at least four licensing executives in its California office, including  
24 George S. Park, Jonathan Takei, Andrew Wu and Rowena Young.

25           17.      Andrew Wu and Jui Min Lim (Licensing Associate & Member of Technical Staff at  
26 IPValue) work in IPValue's Mountain View, California office.

27           18.      Prior to October 27, 2011, Mr. Wu and/or Mr. Lim were involved in preparing claim  
28 charts in California comparing SanDisk flash memory products to Round Rock patent claims.

1           19.     Prior to October 27, 2011, Mr. Wu and/or Mr. Lim reviewed technical information,  
2 including product manuals and photographs of SanDisk flash memory products, for purposes of  
3 determining whether particular Round Rock patents applied to SanDisk's flash memory products.

4           20.     Upon information and belief, IPValue has a financial interest in Round Rock's  
5 licensing activities, including attempts to license SanDisk to Round Rock's patents.

6           21.     Mr. Paul Riley is a Vice President of Licensing at IPValue. Mr. Riley made plans to  
7 and did in fact travel to California for purposes of meeting with SanDisk on October 27, 2011, to  
8 discuss the Round Rock Asserted Patents.

9           22.     Messrs. Riley, Wu and Lim acted as Round Rock's agents for purposes of  
10 commercializing Round Rock's patents with respect to communications and interactions with  
11 SanDisk.

12           23.     Round Rock is the principal of IPValue for purposes of commercializing Round  
13 Rock's patents with respect to communications and interactions with SanDisk.

14           24.     Upon information and belief, Apple, Inc. is headquartered in California.

15           25.     Upon information and belief, Round Rock and/or IPValue have negotiated a patent  
16 license with Apple for a license to patents owned by Round Rock.

17           26.     Upon information and belief, Oracle Corporation is headquartered in California.

18           27.     Upon information and belief, Round Rock and/or IPValue have negotiated with  
19 Oracle for purposes of licensing patents owned by Round Rock.

20           28.     IPValue engages in continuous and systematic activities in California.

21           29.     The Round Rock Asserted Patents have been assigned to Round Rock and those  
22 assignments have been recorded in the United States Patent and Trademark Office ("USPTO").

23           30.     The Round Rock Asserted Patents were assigned from Micron to Round Rock.

24           31.     As the lawful assignee of the Round Rock Asserted Patents, Round Rock is bound by  
25 Micron's prior agreements with third parties with regard to the enforcement of the Round Rock  
26 Asserted Patents.

**FIRST CAUSE OF ACTION**  
**(Declaratory Judgment of Invalidity the '520 Patent)**

32. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

33. The '520 patent issued on April 4, 2006 to named inventor Neal Bowen and is entitled "Stacked chip connection using stand off stitch bonding."

34. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '520 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

35. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '520 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '520 patent by selling "iNAND eMMC EFDs, SSDs, USB flash drives, and the SanDisk family of SD Memory Cards".

36. SanDisk contends that it is not required to license the '520 patent because, among other reasons, the claims of the '520 patent are invalid as anticipated and/or obvious under 35 U.S.C. §§ 102 and/or 103. For example, claims of the '520 patent are anticipated and/or obvious in view of at least the following references: United States Patent Nos. 5,328,079, 5,422,435, 6,136,838, 6,555,401, 6,561,411, and 6,580,092, and Japanese Patent Publication Nos. JP2000114452A and JP10229100A.

37. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to the validity of the '520 patent.

38. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '520 patent are valid. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '520 patent.

**SECOND CAUSE OF ACTION**  
**(Declaratory Judgment of Invalidity the '839 Patent)**

39. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

40. The '839 patent issued on May 7, 2002 to named inventor Larry Kinsman and is entitled "Vertically mountable semiconductor device and methods."

41. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '839 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

42. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '839 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '839 patent by selling "SanDisk microSD Memory Cards".

43. SanDisk contends that it is not required to license the '839 patent because, among other reasons, the claims of the '839 patent are invalid as anticipated and/or obvious under 35 U.S.C. §§ 102 and/or 103. For example, claims of the '839 patent are anticipated and/or obvious in view of at least the following references: United States Patent No. 5,668,409 and R.A. Henle, *Vertical Chip Packaging*, IBM Technical Disclosure Bulletin, Vol. 20, No 11A, pp. 4339-4340 (April 1978).

44. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to the validity of the '839 patent.

45. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '839 patent are valid. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '839 patent.



**THIRD CAUSE OF ACTION**  
**(Declaratory Judgment of Invalidity the '528 Patent)**

46. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

47. The '528 patent issued on May 31, 2005 to named inventors Leonard Mess, Jerry Brooks and David Corisis and is entitled "Stacked mass storage flash memory package."

48. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '528 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

49. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '528 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '528 patent by selling "SanDisk iNAND eMMC EFDs, SSDs, USB flash drives, and the SanDisk family of SD Memory Cards with eight (8) GB or higher capacity".

50. SanDisk contends that it is not required to license the '528 patent because, among other reasons, the claims of the '528 patent are invalid as anticipated and/or obvious under 35 U.S.C. §§ 102 and/or 103. For example, claims of the '528 patent are anticipated and/or obvious in view of at least the following references: United States Patent Nos. 5,998,864, 6,252,305 and 6,605,875.

51. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to the validity of the '528 patent.

52. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '528 patent are valid. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '528 patent.

**FOURTH CAUSE OF ACTION**  
**(Declaratory Judgment of Non-Infringement of the '345 Patent)**

53. SanDisk incorporates by reference the allegations set forth in paragraphs 1 through 31 of this Second Amended Complaint as though set forth in full herein.

54. The '345 patent issued on October 28, 1997 to named inventors Frankie Roohparvar and Michael Briner and is entitled "Non-volatile data storage unit method of controlling same."

55. On or around August 3, 2011, Round Rock wrote a letter to SanDisk asserting ownership of the Round Rock Asserted Patents, including the '345 patent. Round Rock asserted that SanDisk flash memory products incorporate and use features and functionalities covered by the Round Rock Asserted Patents and identified "all SanDisk Flash memory products" as infringing "these patents, either directly or indirectly."

56. Round Rock has asserted that "All SanDisk Flash memory products" infringe the Round Rock Asserted Patents, including the '345 patent. On April 5, 2012, Round Rock alleged in a counterclaim that SanDisk infringed the '345 patent by selling "SanDisk microSD memory cards and iNAND eMMC EFDs".

57. SanDisk contends that it is not required to license the '345 patent from Round Rock because, among other reasons, the claims of the '345 patent are exhausted with respect to SanDisk's flash memory products. On information and belief, the accused flash memory products were made and initially sold by a licensee under the '345 patent. Because the accused flash memory products were sold by an authorized licensee, Round Rock's rights under the '345 patent are exhausted.

58. As a result of the acts described in this Second Amended Complaint, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment as to infringement of the '345 patent by SanDisk.

59. An actual and justiciable controversy exists between SanDisk and Round Rock as to whether the claims of the '345 patent are infringed by SanDisk's flash memory products. A judicial declaration is necessary and appropriate so that SanDisk may ascertain its rights regarding the '345 patent.